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EXAMINER

GAGLIARDI, ALBERT J

ART UNIT PAPER NUMBER

2878

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/922,007

Applicant(s)

GAINSBOROUGH, LAURENCE

Examiner

Albert J. Gagliardi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Comment on Submissions*

1. The response filed 30 June 2003 has been entered.

### *Priority*

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on August 3 2001. It is noted, however, that applicant still has not filed a certified copy of the Canadian application as required by 35 U.S.C. 119(b).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer (US 3,584,412) in view of Zhang (US 6,476,391 B1).

Regarding claim 1, *Palmer* discloses a method of controlling unruly persons comprising: identifying an area containing unruly persons; filling an area with non-toxic, non-injurious material which interferes with the visual sense of person in the area to prevent the persons from orienting themselves and prevents persons from seeing other persons in the area; and causing at least one authorized person to subdue the unruly persons (col. 15, lines 33-46).

Regarding steps of providing at least one authorized person with a thermal imaging camera operable to detect person within the area and generate an image of the detected persons and providing at least one authorized person within the area with a viewing device for viewing an image of the detected person, those skilled in the art appreciate that it is well known to utilize thermal imaging systems to allow for the viewing of persons within clouds of smoke, fog, and

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other low visibility areas. *Zhang*, for example, discloses a thermal imaging system (Fig. 1) that allows authorized persons within an area filled with a fogging material (smoke, for example) to detect and view persons that would otherwise be obscured from view (col. 1, lines 49-65). The examiner also notes that it is well known and considered desirable in riot situations to provide authorized persons with equipment (gas masks, for example) that reduces or prevents the authorized persons from being impaired by fogging materials designed to interfere with the visual sense of unruly persons within the area.

Therefore it would have been obvious to a person of ordinary skill in the art to modify the method of controlling unruly persons suggested by *Palmer* to further include steps of providing authorized persons with equipment such as a thermal imaging systems so as allow for the authorized persons to detect, view, and subdue persons within the fogged area in view of the well known use of such imaging systems for use within smoke, fog and other low visibility areas and the obvious advantages thereof.

Regarding claims 2-5 *Zhang* discloses that the camera (20) is mounted on a headpiece such as a helmet (10), and wherein the viewing device (32) is mounted on a support of the helmet to be carried in front of the eye.

Regarding claim 6, although not specifically suggested by *Palmer* and *Zhang*, it is well known in riot situations as well as other law enforcement actions to record images of scene in order to maintain a record of the activities for future reference and, therefore, it would have been obvious to a person of ordinary skill in the art to modify the method of controlling unruly persons suggested by *Palmer* and *Zhang* so as to further include a recording step so as to allow for maintaining a record of the action in view of the known desirability of doing so.

Regarding claims 7-9, absent some degree of criticality, the manner of subduing the unruly would have been an matter of routine design choice within the skill of a person of

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ordinary skill in the art depending on the needs of the particular application and the desired effect.

Regarding claims 10-11, *Palmer* discloses that the unruly persons are prisoners in a correctional or rioters (col. 15, lines 32-50).

Regarding claims 12-15, the claimed apparatus for use in controlling unruly persons is suggested by the method suggested by *Palmer* and *Zhang* as applied above and is rejected accordingly.

***Response to Arguments***

5. Applicant's arguments filed 30 June 2003 have been fully considered but they are not persuasive.

6. Regarding applicant's argument that the *Palmer* teaches away from the present invention because *Palmer* does not specifically teach that the authorized persons would enter the fogged area while the fog is still in place, the examiner disagrees. The examiner notes that while there is no specific teaching in *Palmer* for authorized persons to enter the area while the fog is in place, there is also no specific teaching that authorized persons must remain outside of the area until the fog dissipates as the applicant suggests. As such, the examiner considers that *Palmer* does not teach away from the claimed invention, but is merely ambivalent as to whether or not authorized persons should enter the area. Since there is no specific teaching away from the claimed invention, the examiner considers that it would be proper to establish obviousness by combining or modifying the teachings of the prior art to produce the claimed invention by some teaching, suggestion, or motivation found either in either additional references or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01.

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7. Regarding applicant's argument that there is no evidence that the infrared imaging system disclosed by *Zhang* would be effective for viewing persons in the fogging material (i.e., the references fail to show certain features of applicant's invention), it is noted that the features upon which applicant relies (i.e., some special or unique properties of a thermal imaging camera) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this instance, the claimed invention merely refers to the use of a thermal imaging camera. Absent some specifically claimed limitation that further defines the infrared imaging camera, the thermal imaging camera disclosed by *Zhang* is considered as meeting all the limitations as claimed.

8. Regarding applicant's argument that *Zhang* does not suggest preventing persons from seeing authorized persons, the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case it is the combination of references and the common knowledge available to one skilled in the art that suggests that the unruly persons are prevented from seeing the authorized person. One notes that common sense suggests that if the authorized person cannot see other persons without benefit of the imaging camera, it follows that such other persons cannot see the authorized person.

The examiner further notes that such argument seems to be based, implicitly at least, on some quality of the fog that limits visibility to some unclaimed maximum distance. As noted above, the claims are interpreted in light of the specification; limitations from the specification

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are not read into the claims. If the fog has some specific quantifiable property that distinguishes the invention from that suggested by the prior art, it must be claimed.

9. Regarding applicant's argument that *Palmer* teaches away from the claimed invention because *Palmer* discloses assembling an "overwhelming" force, the examiner notes that such a statement mischaracterizes the disclosure of *Palmer*, which refers only to an "adequate" force (col. 15, lines 43-46). The examiner further notes that regardless of the number of authorized persons suggested by *Palmer*, such number meets the claim limitation of "at least one."

10. Regarding applicant's argument that there is simply no motivation in the references themselves or the knowledge commonly available to those skilled in the art, the examiner disagrees. As noted in applicant's argument (page 2, par. 2,) that it "is well established that control of crowds or riots is effected by 'adequate' or overwhelming force . . . ." Those skilled in the art also appreciate that what is considered as an "adequate" force is unique to the situation and based on a variety of factors, most notably the actual number of persons in the two forces and the particular equipment available to the forces; all other things being equal, it is well settled that the number of people persons considered as adequate is inversely proportional to the quality of the available equipment. As such, the desire to provide advantages to one group by the use of better equipment is considered a well-known and obvious motivation (any specific examples discussed above merely illustrative of the general concept) that is as old as the history of conflict itself. The examiner also notes that there is an old saying that "in the land of the blind, a man with one eye would be king." As such, common knowledge alone (not to mention the suggestion by *Zhang*) would have suggested the desirability of using infrared imaging to "see" in low visibility situations (smoke, dust, fog, and darkness, for example) where others are "blind."

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11. Regarding applicant's argument, as best understood, that *Zhang* is non analogous art because the present invention is concerned with control of persons, while *Zhang* is concerned with firefighters, the examiner notes that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, *Zhang* is pertinent to the problem with which applicant is concerned, namely enhanced imaging in low visibility conditions.

12. Regarding applicant's additional points, the examiner notes that: points 1 and 2 are addressed in the above response; point 3 is irrelevant because it is the fact of disclosure, not the number of lines used in the disclosure, that is pertinent to whether or not something is known in the art and also because *Palmer* is concerned with riot control, not fire fighting as asserted by applicant; point 4 is irrelevant because the examiner does not suggest that gas masks would have any advantage in the present situation; point 5 and 6 are irrelevant because examiner does not suggest that the claimed invention is not new or useful, only that it would have been obvious; and point 7 is directed to qualitative and quantitative limitations that are not claimed.

13. Regarding the attached letter, the examiner note that such letter, even if such letter were considered as an affidavit or declaration under 37 CFR 112 (which it is not), the letter merely points out that the invention is useful, a point that is already conceded by the examiner.

14. Although not argued by applicant, the examiner notes that even if applicant's argument regarding the method of claim 1 were considered adequate, such arguments would be inadequate against the apparatus of claim 12 because apparatus claims must be structurally distinguishable

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from the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). See MPEP 2114. In this case, the claimed apparatus is structurally indistinguishable from the apparatus suggested by the prior art.

15. All of applicant's arguments having been addressed, the rejection is maintained.

### **Conclusion**

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert J. Gagliardi whose telephone number is (703) 305-0417. The examiner can normally be reached on Monday thru Friday from 9 AM to 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (703) 308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Albert J. Gagliardi  
Examiner  
Art Unit 2878

AJG  
July 27, 2003